

## **REMARKS**

Applicants thank the Examiner in his courtesy of clarifying the status of the claims and the Amendment mail date in the instant case during telephonic communications with the Examiner.

### **1. Status of the Claims**

Claims 1-13 stand cancelled. Claims 14-29 stand pending and under a restriction requirement.

Applicants have cancelled claims 14-29 without disclaimer of or prejudice to the subject matter contained in those claims. Applicants have introduced new claims 30-38. Support for these claims can be found at least in original claims 1-13. Accordingly, Applicants assert that no prohibited new matter will have been introduced by the entry of the new claims. Applicants reserve the right to file a divisional and/or continuation application on any subject matter canceled by way of the amendment.

### **2. Election with Traverse**

Applicants respectfully elect **Group I** (*i.e.*, claims 14-16, 18-22, 24-26, and 28-29) for further prosecution, *with traverse*. Applicants further elect a species for search purposes *with traverse* of a DNA sequence of SEQ ID NO: 1 and an amino acid sequence of SEQ ID NO: 2.

#### **2.1 Traversal of the Restriction of the Claims into Groups I-III**

The instant application is a national phase application of an International PCT Application. Therefore, 37 C.F.R. §§ 1.499, 1.475, 1.143 and 1.144 apply. Restriction practice under 35 U.S.C. § 121 and its associated rules do not apply. *See* M.P.E.P. § 1895.01. Unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. 37 C.F.R. § 1.475. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.* The Office Action states "that the claims are not linked by a single technical feature because they are each drawn to products and processes not shared by the other." Office Action, page 3, ¶3.

The discretionary nature of restrictions is kept even if the application is filed as a national stage application. M.P.E.P. § 803 states that an application may be properly

PATENT

restricted to one or more claimed inventions *only* if (1) the inventions are independent or distinct as claimed, *and* (2) there is a *serious burden* on the Examiner if restriction is not required. Under M.P.E.P., the restriction requirement demands that not only must there be a burden, but it must be a *serious* burden. Applicants respectfully assert that the Examiner need not have restricted the claims into 3 groups with a further election of sequences given the finding of unity. M.P.E.P. § 803 requires that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Thus, restriction is a *discretionary tool*. It is not something that is required.

Applicants first point out that unity of invention was found in the International PCT Application. The Office is to give credence to such findings of unity of invention in the International PCT application. The Office must further point out that there is not only reason for the restriction but *serious burden* on the Office absent a restriction. This serious burden only is magnified when unity was found during by the International Search Authority. Additionally, the Office must provide credible reasoning to substantiate a serious burden that overcomes the finding of unity by the International Search Authority. Absent such argumentation, the requirement of a restriction is improper. Applicants direct the Office to the Restriction Training Materials at. As no evidence of serious burden substantiated by credible reasoning was presented by the Office, the restriction is improper.

Applicants also point out that SEQ ID NOS: 1-3 differ from what is disclosed in U.S. Patent No. 5,952,545. Applicants therefore assert that the claims possess a special technical and should therefore be examined together.

Applicants further point out that a claim cannot span more than one group. Yet, claim 27 is alleged to be in both Group II and Group III. Such a split on a single claim is improper. Applicants request clarification in the Office’s next communication.

Group II is directed to a construct or vector allegedly comprising a polynucleotide in an antisense direction. Even with previously pending claims 14-29, the polynucleotide was not in the antisense direction. Rather, the promoter in one instance (claims 17 and 23) was in the antisense reading frame. As the polynucleotide forms the special technical feature and not the promoter alone, Applicants submit the restriction is improper and should be withdrawn. The claims of Group II should at least be rejoined with the claims of Group I.

The claims of Group III are drawn to a method of transforming plants. A method of transforming plants with the polynucleotide, wherein the polynucleotide forms the special technical feature would not create a serious burden on the Office to search, because the searches would be coextensive. Accordingly, the claims of Group III likewise should be rejoined with the claims of Group I.

Thus, at least for the reasons addressed above, Applicants request reconsideration and withdrawal of the restriction. The claims should be rejoined and examined together.

## 2.2 Traversal of the Species Election

Applicants were further mandated to elect one DNA (SEQ ID NO: 1) and one corresponding amino acid sequence (SEQ ID NO: 2) of claim 14. Whether this is a species election or a further restriction is unclear from the restriction requirement. Applicants request clarification of the restriction in the Office's next communication.

Assuming that this is an election of species, Applicants traverse the election for at least the following reasons. First, Applicants have essentially rewritten claim 14 into claim 30. Applicants point out that claim 30 is directed to a polynucleotide that comprises two nucleotide sequences. The nucleotide sequences are SEQ ID NO: 1 and 3, which respectively encode a protein of SEQ ID NO: 2 or 4 respectively (with or without variation). To force an election of one DNA only would thwart the subject matter claimed, because the two nucleotide sequences each form a part of the polynucleotide. Applicants point out that if this is a restriction of the sequences, such a result would be wholly untenable as it would result in subject matter that is not thing claimed. The same is true for the election of the amino acid sequence. Thus, Applicants respectfully request withdrawal of the election of a sequence drawn to a DNA and an amino acid sequences.

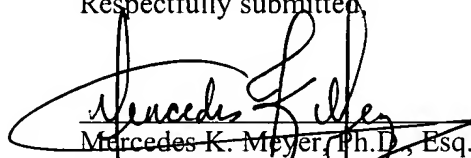
**CONCLUSION**

Should the Examiner have any questions or comments regarding Applicants' amendments or response, he is asked to contact Applicants' undersigned representative at (202) 842-8821. Please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number. The undersigned is signing in her authority under 37 C.F.R. § 1.34(b).

Date: December 14, 2006

Respectfully submitted,

  
Mercedes K. Meyer, Ph.D., Esq.  
Registration No. 44,949  
DRINKER BIDDLE & REATH LLP  
1500 K Street, NW, Suite 1100  
Washington, DC 20005-1209  
Tel: (202) 842-8821  
Fax: (202) 842-8465